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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jay Paul Drummond, et al.

Appeal No.: 2007-4204

Application No.: 09/639,310

Confirmation No.: 9530

Filed: August 14, 2000

Title: Automated Banking Machine
Customer Profile Method

Art Unit 3624

Patent Examiner
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Commissioner for Patents
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Alexandria, VA 22313-1450

Sir:

DECLARATION PURSUANT TO 37 C.F.R. § 1.132

I, Mark D. Smith, hereby declare as follows:

1. I am an employee of Diebold, Incorporated and have worked in the past for InterBold, a wholly owned subsidiary of Diebold, Incorporated (collectively referred to hereafter as "Diebold"). I have extensive experience as an engineer and engineering manager in the development of automated banking machines and associated computer software for those machines. I began working in the automated banking machine industry in approximately 1977.
2. Based on my knowledge and experience, a person having ordinary skill in the art of automated banking machines at the time the present invention was made would have a four-year college degree in engineering, such as mechanical or electrical engineering, and have at least four years of experience in designing automated banking machines (or equivalent years of working experience in the design of automated banking machines).
3. I have reviewed the subject matter disclosed in the above-mentioned application (hereinafter "application").
4. I have reviewed the appealed claims (hereinafter "claims") involved in the Board decision decided April 17, 2008 (hereinafter "decision").
5. I have reviewed the references involved in the decision, including the patent to Wagner (US 5,742,845).

A person having ordinary skill in the art of automated banking machines at the time of the invention (corresponding to the application) would not have considered an ATM to be a "non-standard I/O device" as described in Wagner. Wagner's extended protocols are directed to use with non-standard I/O devices.

A person having ordinary skill in the art of automated banking machines at the time of the present invention would have determined from Wagner that an ATM is not a "non-standard I/O device". It would have been determined that Wagner distinguishes "non-standard" I/O devices from "standard" I/O devices. For example, Wagner, as best understood, implies that *standard* I/O devices are those I/O devices that can already be supported by Internet protocols, such as computers, whereas *non-standard* I/O devices are those I/O devices which do not have the capability of direct communication on a network, so they require use of other communication interfaces such as RS-232C. That is, Wagner indicates that a non-standard I/O device is not a computer (which an ATM comprises). For example, note Wagner at col. 3, lines 62-66; col. 4, lines 4-12; col. 5, lines 43-47; col. 6, lines 16-20; col. 9, lines 60-63; col. 10, lines 5-6; and abstract lines 5-6. This indicates to a person having ordinary skill in the art of automated banking machines at the time of the present invention that Wagner teaches away from an ATM being a non-standard I/O device, and thus it would not have been obvious to have used Wagner's extended protocols with an ATM.

Wagner is directed to a system that permits a consumer to initiate a transaction and order from a merchant, and then switch to a conventional secure (credit card) processing application for the confidential financial aspects of the transaction. This

conventional secure processing application includes use of a known (not an extended) protocol, such as the VISA protocol. However, ATMs at the time of the present invention communicated using proprietary debit card protocols, such as those used by Cirrus® and Plus®, and not Visa point of sale credit card processing protocols. This indicates to a person having ordinary skill in the art at the time of the present invention that an ATM is further removed from being a “non-standard I/O device” as described in Wagner. As a result, it would not have been obvious to a person having ordinary skill in the art at the time of the present invention to have used Wagner’s extended protocols with an ATM, especially to control an ATM.

A person having ordinary skill in the art of automated banking machines at the time of the present invention would not have been able to make and use the purported invention in Wagner based on the disclosure provided by Wagner. As best understood, Wagner’s disclosure is non-enabling. For example, Wagner’s use of the term “non-standard I/O device” would have been unclear to a person having ordinary skill in the art at the time of Wagner’s application. Wagner provides examples of non-standard I/O devices, such as smart card reader (32), PIN pad (34), magnetic card swipe reader (36), and printer (38). To a person having ordinary skill in the art at the time of Wagner’s application, “I/O” means “input/output.” However, none of these devices is technically an input/output device. A smart card reader, PIN pad, and magnetic card swipe reader are input-only devices. A printer is an output-only device. Thus, Wagner’s use of “I/O device” is not consistent with known accepted terminology in the field. Nor did Wagner specifically redefine the accepted meaning of an “I/O device”.

Nor is the term “non-standard I/O device” one that has an accepted meaning that is well known in the art. Nor is this term defined to a sufficient degree by Wagner to overcome the absence of an accepted meaning in the art. The scope of this term appears to improperly try to encompass every conceivable structure that is not a “standard I/O device.” Such examples would even include paper and a pencil. The undue breath of the term renders the Wagner disclosure indefinite and non enabling. A person having ordinary skill in the art at the time of Wagner’s application would not have been able to ascertain the scope and meaning of Wagner’s disclosed purported invention. A person having ordinary skill in the art at the time of Wagner’s application would have been unable to carry out Wagner’s disclosed purported invention, even with undue experimentation. As a result, Wagner does not teach sufficient information that would have enabled a person having ordinary skill in the art at the time of Wagner’s application to make and use Wagner’s purported invention.

A person having ordinary skill in the art at the time of the present invention would not have considered or recognized a browser to be a requirement of Wagner’s system. Wagner’s system does not specifically teach use of a browser. Nor is there any evidence that Wagner’s system uses or requires a browser. A person having ordinary skill in the art at the time of the present invention would have also understood that HTML documents could be interpreted without a browser. Furthermore, Wagner’s examples of non-standard I/O devices (e.g., smart card reader, PIN pad, magnetic card swipe reader, and printer) do not require a display device, let alone the capability or requirement to display a web page.

It would not have been obvious to a person having ordinary skill in the art at the time of the present invention to have combined the references as alleged by the Office. The present application was filed in 2000 and claims priority back to 1996. At the time of the present invention, ATMs did not employ web pages (except for Diebold). Nor would a person having ordinary skill in the art at the time of the present invention have considered employing Wagner's complicated (and non-enabling) relationship between extended protocols and non-standard I/O devices for ATMs, especially when ATMs did not need such devices to have direct network communication. Furthermore, it would not have been obvious to a person having ordinary skill in the art at the time of the present invention, in view of the Wagner disclosure, how such an employment of any of the teachings in Wagner could have feasibly been carried out, especially to have achieved the invention recited in the claims.

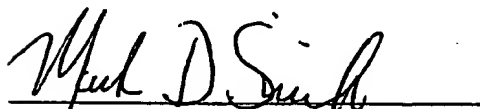
6. I have reviewed the decision. The decision is faulty because, in contrast to an understanding of Wagner by a person having ordinary skill in the art at the time of the present invention (as discussed above), it attributes enablement to Wagner and it also attributes to Wagner features which are not taught or suggested by Wagner.
7. The decision is also faulty because it did not correctly apply the level of ordinary skill in the art at the time of the present invention. As the decision is best understood, the Board applied a level of ordinary skill in the art in 2008. Again, the application covering the present invention was filed in 2000 and claims priority back to 1996.

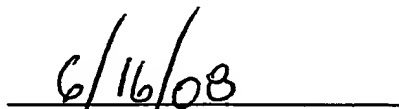
8. The decision is also faulty because there are significant differences between what was disclosed in the applied references and what was recited in the claims. These differences would not have been obvious to a person having ordinary skill in the art at the time of the present invention. Before the present invention, there was no recognized need (or known way) for an automated transaction machine to generate a web page responsive to a customer profile value, and to display the web page through operation of a browser, especially where the web page included selectable transaction options for performing transactions with the automated transaction machine.

To a person having ordinary skill in the art at the time of the present invention, the references, whether taken alone or in combination, did not teach or suggest the features and relationships recited in the claims. Nor would a person having ordinary skill in the art at the time of the present invention have any reason or have recognized any teaching, suggestion, or motivation in view of the references, to have combined the reference's teachings to have obtained the features and relationships of the claims. Rather, a person having ordinary skill in the art at the time of the present invention would have recognized the teachings in the references to be non analogous and incompatible, and that no benefit would have been obtained in prior automated transaction machine operations based on combining such teachings. Conversely, a person having ordinary skill in the art at the time of the present invention would have recognized that combining the teachings would have destroyed the function and intended use of prior automated transaction machine operations.

In conclusion, it would not have been obvious to a person having ordinary skill in the art at the time of the present invention, having full view of all the applied references, to have produced the features and relationships recited in the claims.

9. I hereby declare that all statements herein of my own knowledge are true, that all statements made on information and belief are believed to be true, and that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both (18 U.S.C. § 1001), and may jeopardize the validity of the application or any patent issuing thereon.


Mark D. Smith


Date